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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/626,879

07/25/2003

Jang Han

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1049

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NOVARTIS VACCINES AND DIAGNOSTICS INC.
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EXAMINER

ZARA, JANE J

ART UNIT

PAPER NUMBER

1635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

02/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/626,879	Applicant(s) HAN ET AL.	
	Examiner Jane Zara	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-81 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This Office action is in response to the communication filed 11-22-06.

Claims 1-81 are pending in the instant application.

Election/Restriction

Pursuant to 37 C.F.R. 1.142(a), whereby the distinctness and independence of the inventions of the instant application have become clear upon amendments, an examiner's action on the merits of the amendments and arguments filed by applicant on November 22, 2006 is hereby deferred until an election has been made for the requirements set forth below. (See MPEP 810.02 and 811)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Applicants are required to elect a single target 3'-UTR polynucleotide from claims 1, 10, 14, 24, 28, 38, 43 and 57.

The inventions are distinct, each from the other because of the following reasons:

Inventions comprising the different target nucleotide sequences are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different target genes or sequences listed are patentably distinct for the following reasons. The different

Art Unit: 1635

target sequences listed in claims 1, 10, 14, 24, 28, 38, 43 and 57 are functionally, structurally, biologically and chemically different and distinct from each other. For these reasons, the inventions listed in the various Groups are patentably distinct.

Inventions comprising the different nucleic acid molecules or target sequences of claims 1, 10, 14, 24, 28, 38, 43 and 57 are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The nucleic acids of each Group are not required for the methods steps of each of the other Groups. The operation, function and effects of the different polynucleotides are completely different and distinct from the operation, function and effects of the methods of each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the different polynucleotides or target regions listed in claims 1, 10, 14, 24, 28, 38, 43 and 57, and encompassed by claims 1-81 are subject to restriction. In the instant case, one independent and distinct nucleotide target sequence will be examined in a single application without restriction. Those sequences which are patentably indistinct from the sequence or region selected by the applicant will also be examined.

Claims 1-81 specifically embrace different polynucleotide targets with different SEQ ID Nos. Each of these polynucleotides is considered to be structurally independent, because each is represented by a unique nucleotide sequence. Furthermore, a search of all the sequences claimed presents an undue burden on the Patent and Trademark Office to search and examine. In view of the foregoing,

Art Unit: 1635

applicants are required to elect up to **ONE (1)** SEQ ID No. or corresponding polynucleotide target sequence.

Searching all of the different target nucleotides recited in the methods together would impose a serious search burden. In the instant case, the search of the different target sequences, for instance, are not coextensive. There is a search burden also in the non-patent literature to search all of the different nucleotide targets listed.

Searching, therefore is not coextensive. As such, it would be burdensome to search the inventions of all of the different target sequences.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. ' 1.6(d)). The official fax telephone number for the

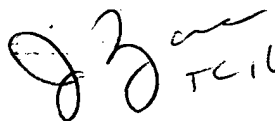
Art Unit: 1635

Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Zara whose telephone number is (571) 272-0765. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz, can be reached on (571) 272-0763. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jane Zara
2-11-07


JANE ZARA, PH.D.
PRIMARY EXAMINER